

REMARKS

Claims 15-17 are pending. By this Amendment, claims 15-17 are amended and claims 18-35 are added. No new matter has been added as claims 18-35 correspond to claims previously pending in U.S. Patent Application No. 12/338,703, which claims priority as a continuation of the present application.

Claim Rejections 35 USC § 112

Claim 16 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Office Action asserts that it is not clear how the limitation of “an employer job advertisement” can be a part of a system. Although Applicant does not acquiesce in the position set forth in the Office Action, this limitation has been removed from Claim 16 in this Amendment. The rejection is therefore moot and Applicant respectfully requests that it be withdrawn.

Claim Rejections 35 USC §102

The Examiner has rejected claims 15-17 under 35 U.S.C. §102(b) as being anticipated by Ed Rubenstein, *Operators Embrace Automated Systems to Hire the Best, Reduce Turnover*, Nation’s Restaurant News, June 23, 1997. These rejections are respectfully traversed.

Rubenstein discloses four distinct systems for hiring operations – the “HReasy” system, the “DPDApplicant” system, and the Aspen CAPS and ApView systems. Each of these systems is an independent system. In using Rubenstein to reject the present Application for anticipation,

the Office Action combines aspects of the distinct systems. However, the Office Action does not cite any single system as disclosing each and every element of the claims.

The Federal Circuit has recently held that it is improper to combine features of one system with features of another system, even if they are disclosed in the same reference, to find anticipation. Net MoneyIn, Inc. v. Verisign, Inc., Opinion No. 2007-1565, October 20, 2008. In Net MoneyIn, a reference disclosed two distinct protocols for processing credit card transactions. (Id., p. 3.) The district court held that the claim in issue was anticipated by the reference based on a combination of the disclosures of the two protocols. (Id., p. 13.) The Federal Circuit reversed, stating that to establish anticipation a reference “must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements arranged as in the claim.” (Id., p. 15.) Thus, it was wrong to combine elements from both of the protocols in the reference to find that the claim was anticipated where neither protocol disclosed all of the elements of the claim; the issue instead had to be looked at under an obviousness approach. (Id., p. 18.)

The same analysis is true in the present case. The separate systems disclosed in Rubenstein cannot be used together to create a proper anticipation rejection. For this reason alone, Applicant respectfully requests that the anticipation rejection over Rubenstein be withdrawn.

Even if the distinct systems in Rubenstein were to be properly combined in an obviousness rejection, none of the systems in the article still does not disclose a statistical correlation system for validating a set of application questions by statistically correlating job performance ratings of a plurality of hired workers with previous responses given by the workers

to application questions before the workers were hired as required by amended claims 15-17. Accordingly, the claims at issue are not obvious over Rubenstein.

Rubenstein describes systems that ask “a first set of interview questions” which are “closed ended questions requiring yes-no answers – that commonly are found on a traditional paper-based employment applications.” (Rubenstein, p. 1.) The “HReasy” system utilizes “artificial intelligence” to have second-tier questions “matched against the minimum requirements or norms of job to be filed, based on criteria provided by the food-service operator.” (*Id.*, p. 1.) Further, Rubenstein discloses that “an important aspect of HReasy here is its use of artificial intelligence to highlight key areas on which the area or district manager should focus with *each* candidate.” (*Id.*, p. 2 (emphasis added).) The “DPDApplicant” system utilizes questions that “*can* be customized for any foodservice operator.” (*Id.*, p. 2 (emphasis added).) Rubenstein goes on to say that “[t]he processed application is then faxed back to the hiring manager.” (Rubenstein, p. 2) Finally, Rubenstein discloses that “DPDApplicant generates an employee ‘Profiler,’ which over time allows organizations to benchmark the success of its hiring practices by measuring average employee-retention patterns and turnover rates.” (Rubenstein, p. 2)

The Rubenstein disclosure fails to disclose a statistical correlation system for validating a set of application questions by statistically correlating job performance ratings of a plurality of hired workers with previous responses given by the workers to application questions before the workers were hired. Rubenstein merely discloses systems that “can” have their questions customized by the provider. There is no mention in Rubenstein that “[e]mployee performance evaluation measures actual job performance of the applicant or incumbent after holding the job

for a period of time. This information is fed back to test design and/or test administration.” (Dewar, [0101]) Further, Rubenstein mentions only an employee “Profiler” that measures “average” employee retention patterns and turnover which, in turn, will help benchmark the success of hiring practices. Thus, Rubenstein fails to disclose any examination of “job performance ratings” as disclosed in amended claims 15-17, instead Rubenstein merely discloses the examination of entry and exit dates for benchmarks of hiring practices. Further, Rubenstein discloses benchmarking “hiring practices.” Thus, these “benchmarks” merely give indications as to the entire process from initial pre-screen to the in-person interview. Finally, the “HReasy” program, as disclosed in Rubenstein, focuses on *each* candidate during the hiring process. There is no indication that any information is captured after the hiring process is completed and fed back into the system to validate questions posed to the subsequent applicant pool. Thus, Rubenstein does not disclose any system that utilizes job performance ratings of previously hired workers to validate a series of questions posed to applicant during the application process. As such, Applicant respectfully submits that a rejection cannot be maintained against claims 15-17 on the basis of Rubenstein.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'BP', with a long horizontal line extending to the right.

Brad Pedersen  
Registration No. 32,432

Application No. 09/878,245

Customer No. 24113  
Patterson, Thunte, Skaar & Christensen, P.A.  
4800 IDS Center  
80 South 8th Street  
Minneapolis, Minnesota 55402-2100  
Telephone: (612) 349-5774